

REMARKS

Applicant thanks the Examiner for a thorough examination of the present application, and respectfully requests reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow. At the time of the outstanding Office Action dated October 7, 2009, claims 1-21 and 43-48 were pending, all of which have been amended. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, is presented, with an appropriate defined status identifier. Upon entry of this response, claims 1-21 and 43-48 will be pending.

I. 35 U.S.C. § 112, Second Paragraph

The Office Action rejects claim 43-48 under 35 U.S.C. § 112, second paragraph, for allegedly failing to provide proper antecedent basis for “the active portion” in line 6 of claim 43. (Office Action at 2.) Applicant respectfully disagrees with this rejection. In particular, Applicant respectfully submits that the recitation of “an active portion” in line 7 of amended claim 43 provides proper antecedent basis for “the active portion” in line 8 of amended claim 43. Therefore, Applicant respectfully requests withdrawal of this rejection.

II. 35 U.S.C. § 102(b)/103(a)

The Office Action rejects claims 1, 4-8, 10, 12, 16, 18, 20, 43-45, 47, and 48 under 35 U.S.C. § 102(b) as being anticipated by JP 09-034638 (“Matsuda”). (Office Action at 2.) In addition, the Office Action rejects claims 2 and 15 under 35 U.S.C. §103(a) as being unpatentable in view of Matsuda in view of U.S. Patent No. 5,442,348 (“Mushell”). (Office Action at 4.) Furthermore, the Office Action rejects claim 3 under 35 U.S.C. §103(a) as being unpatentable in view of Matsuda in view U.S. Patent No. 6,119,944 (“Mulla”). (Office Action at 5.) Still further, the Office Action rejects claims 9, 21, and 46 under 35 U.S.C. §103(a) as being unpatentable in view of Matsuda in view U.S. Patent Application No. 2002/0047867 (“Mault”). (Office Action at 6.) Finally, the Office Action rejects claims 11, 13, and 14 under 35 U.S.C.

§103(a) as being unpatentable in view of Matsuda in view U.S. Patent No. 6,563,494 (“Eichstaedt”). Applicant traverses these rejections for at least the reasons set forth below.

With regard to independent claims 1, 10, and 43, the Office Action asserts that Matsuda discloses all of the elements required in these claims. Although Applicant does not agree with or acquiesce to this assertion, in the interest of advancing prosecution, Applicant has amended each of these claims to more particularly describe aspects of the application. As discussed in detail below, independent claims 1, 10, and 43, as amended, are patentable over the references cited in the Office Action.

A. Memory Tag

Matsuda discloses a “system which performs movement and a copy of data between the same terminal unit or two or more terminal units.” (Matsuda at para. [0001].) As illustrated in Figure 1 of Matsuda, the system includes a terminal unit (element 1) and a electronic pen (element 2). More specifically, Matsuda illustrates the terminal unit as a computing device. Thus, Matsuda teaches that the electronic pen can be used to move data from one computing device to another computing device, or within the same computing device.

In contrast to Matsuda, independent claims 1, 10, and 43 recite uploading/downloading data to/from a “memory tag.” As described in paragraphs [0001] - [0005], [0020], and [0021] of the present application, for example, a “memory tag” generally refers to a small, not-self powered, memory device which includes an antenna coil and a capacitor. The term is well-established in the relevant art and cannot be reasonably interpreted as either the terminal unit (element 1) or the electronic pen (element 2) of Matsuda. That is, in contrast to the Office Action’s assertion that the terminal unit and/or electronic pen of Matsuda corresponds to the claimed memory tag, Applicant respectfully submits that one of ordinary skill in the art would not reasonably consider any of these teachings in Matsuda to relate to the claimed “memory tag.” This is especially true in light of the generally understood definition of “memory tag” in the relevant art, and in light of the description in the specification.

Although the claimed “memory tag” is distinguishable from the cited references for at least the reasons mentioned above, in the interest of compact prosecution, Applicant has further amended independent claims 1, 10, and 43 to recite that the “memory tag is inductively powered.” Because Matsuda does not make any indication that the terminal unit (element 1) or electronic pen (element 2) is inductively powered, nor would one of ordinary skill in the art consider these types of devices to potentially be inductively powered, Applicant respectfully submits that Matsuda cannot reasonably be interpreted as disclosing the claimed “memory tag.”

B. Automatic Uploading from Memory Tag

Matsuda discloses that a “copy key” and “paste key” on the electronic pen (element 2) are used to initiate the copying and pasting functions. (Matsuda at [0008]). In contrast to Matsuda, independent claim 1, as amended, recites that “the data is automatically uploaded to the memory tag reader from the memory tag when the memory tag reader is brought adjacent to the memory tag.” Independent claim 43, as amended, recites a similar feature. Because Matsuda discloses a manual operation which requires a depression of a copy key, Applicant respectfully submits that Matsuda cannot be reasonably interpreted as *automatically* uploading data when a memory tag reader is proximate to the memory tag.

Furthermore, Applicant submits that Mushell cannot be reasonably interpreted as teaching this feature absent from Matsuda. Mushell discloses a “Touch Pen 500 for collecting data from multiple, dispersed computerized parking meters via Touch Memory.” (Mushell at 12:49-51.) Additionally, Mushell discloses that the “Touch Pen 500 has a Touch Probe 501 which collects data from multiple Touch Memories and stores it in up to 128K of nonvolatile memory.” (Mushell at 12:51-54.) Accordingly, Mushell teaches a pen that acquires data from memories. Mushell, however, does not mention anything about *automatically* uploading data when a memory tag reader is proximate to the memory tag. That is, Mushell does not specify if the retrieval of data is automatically triggered or manually triggered. Without such an express teaching, any interpretation of the data retrieval as automatic would be based on speculation, and

therefore not be reasonable. Accordingly, Mushell cannot be reasonably interpreted as teaching this feature absent from Matsuda.

C. Upload/Download When Reader/Writer Lifted

As discussed above in Section II(B), Matsuda teaches that data is uploaded and/or downloaded when a “copy key” and/or “paste key” is depressed. (Matsuda at [0008]). In contrast to Matsuda, independent claim 1 recites that “the downloading occurs when the memory tag reader is lifted from its location adjacent to the active portion of the other device.”

Independent claim 43 similarly recites that “the data is transferred when the memory tag reader is lifted from a location adjacent to the active portion of the other device.” Furthermore, independent claim 10 recites that “the uploading automatically occurs when the memory tag reader/writer is lifted from its position adjacent to the active portion of the other device.” Thus, in contrast to Matsuda, which requires a “copy key” and/or “paste key” is depressed to initiate uploading/downloading to and from the terminal unit, the claims recite that the data is automatically transferred when the memory tag reader is lifted from a location adjacent to the active portion. Because Matsuda does not disclose (1) *automatic* upload/download, and (2) automatic upload/download when a *memory tag reader is lifted*, Applicant respectfully submits that Matsuda cannot be reasonably interpreted as disclosing this feature.

CONCLUSION

With regard to any cited reference not discussed above, Applicant submits that these remaining prior art references were relied upon by the Examiner merely as alleged evidence of one or more limitations recited in the dependent claims of the present application. However, none of these remaining references cures the above-discussed deficiencies of Matsuda and Mushell, nor has the Examiner asserted that they do.

Because none of the references cited by the Examiner, either separately or in combination with each other, teaches or suggests all of the features recited in independent claims 1, 10, and 43, Applicant submits that independent claims 1, 10, and 43 are patentable over these cited

references. Furthermore, because dependent claims 2-9, 11-21, and 44-48 are each directly or indirectly dependent upon independent claims 1, 10, and 43, Applicant submits that each of these claims are allowable for at least the same reasons discussed above, in addition to their own reasons which Applicant reserves the right to argue at a later time if necessary.

Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested. The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 08-2025. Should no proper payment be enclosed herewith, as by the credit card payment instructions in EFS-Web being incorrect or absent, resulting in a rejected or incorrect credit card transaction, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 08-2025. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. § 1.136 and authorizes payment of any such extensions fees to Deposit Account No. 08-2025.

Respectfully submitted,

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By 

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